

Applicants submit that the prohibition against amending a declaration after signing by an inventor, as stated in the above-quoted section of the Manual of Patent Examining Procedure (MPEP), is intended to prohibit changes in parts of the declaration to which a signing inventor is subscribing. An inventor is not required to affirm in a declaration that the residence, address and country of citizenship of each other inventor is as given in the declaration (see 35 U.S.C § 115 and 37 C.F.R. § 1.63). In fact, it would be expected that, typically, an inventor has no basis for knowing such other information concerning the other inventor(s). Therefore, Applicants submit that the above-indicated prohibition against amending a declaration after signing by an inventor is not intended to prohibit correction by an inventor of that inventor's address after the declaration has been signed by another inventor. There would seem to be no reason for such a prohibition. Nevertheless, with this Response, Applicants have submitted a new Declaration and Power of Attorney for Patent Application, signed by all of the inventors, thereby obviating the Examiner's finding that the originally submitted declaration was defective.

Rejection of Claims and Summary of Response

Claims 1-67 were filed and are pending. Claims 1-67 were rejected under 35 U.S.C. § 102. Claims 1 and 66 have been amended. Reconsideration and allowance of Claims 1-67 is requested.

Rejection of Claims under 35 U.S.C. § 102

The Examiner rejected Claims 19, 21, 22, 46, 48, 66 and 67 under 35 U.S.C. § 102(b) as being anticipated by Pirani et al.

Claim 19 recites:

A system for engaging the peripheral attention of a person in the vicinity of a display device of an apparatus, comprising:

means for acquiring a set of content data from a content providing system; and
means for selectively displaying on the display device, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from the set of content data.

Pirani et al. teach "methods of displaying and integrating commercial advertisements with software programs" (column 1, lines 8-10). Though Pirani et al. do not describe how a method for producing such integration is implemented, the description given in Pirani et al. indicates that such integration is accomplished by appropriately modifying a software program to provide display of advertisements as part of the operation of the software program. For example, in Claim 1, Pirani et al. state that a "commercial advertisement is to be placed in the different parts of a computer software so that such commercial advertisement becomes an integral part of such software" (emphasis added).

In contrast, in a system as in Claim 19, content data is not integrated into means (e.g., software) for displaying images generated from content data, nor is content data integrated into means (e.g., software) for providing a primary interaction with an apparatus with which the system is used. In a system as in

Claim 19, content data is typically acquired from a content providing system that is different from the system of Claim 19 or the associated apparatus. Thus, the content data is not integrated into the means for selectively displaying (part of the system of Claim 19) or into means for providing a primary interaction with the associated apparatus (part of that apparatus). As will be appreciated from the discussion below, this lack of integration enables display of images generated from a wide variety of content data and also enables the content data to be selectively used to generate images for display.

Further, Pirani et al. teach that "[the invention described herein] does not require a telephone or a modem" (column 1, lines 58-59). Thus, Pirani et al. contemplate that advertisements are to be integrated into, and displayed during operation of, software that is installed on a computer via "conventional" means (e.g., by installing software stored on a floppy disk or CD-ROM), not software that is obtained via a computer network. Consequently, Pirani et al. do not teach a system for use with an apparatus in which the system includes "means for acquiring a set of content data from a content providing system," as recited in Claim 19. Rather, as indicated above, Pirani et al. teach that advertisements are integrated into software that is resident on a computer. Further, Pirani et al. do not suggest such means: since the advertisements are already present on the computer, there is no need to obtain advertisements from another system. In the system of Claim 19, on the other hand, content data can be obtained from a content

providing system with which the system of Claim 19 and/or the associated apparatus can communicate. Pirani et al. do not teach or suggest such a system, but, rather, teach the use of "enhanced" software (i.e., software including advertisements) that operates on a computer without need to communicate with another device.

As a result of the above-described differences, a system as in Claim 19 has important advantages over the enhanced software taught by Pirani et al. For example, a system as in Claim 19 allows a much larger variety and number of images to be displayed than is possible with the enhanced software taught by Pirani et al. A system as in Claim 19 can access many content providing systems, each of which may have a large capacity for storing content data. It can readily be appreciated, then, that the variety and number of images that can potentially be displayed by a system as in Claim 19 can be vast. The enhanced software taught by Pirani et al. is much more restricted: the variety and number of advertisements that can be displayed is limited by the capacity for storing such advertisements that is available on the computer with which the enhanced software is used.

Finally, Pirani et al. also do not teach or suggest a "means for selectively displaying ... an image or images generated from [a] set of content data," as recited in Claim 19. While Pirani et al. teach that advertisements can be displayed in different ways (see, e.g., column 6, lines 3-10), Pirani et al. do not teach or suggest that the manner in which advertisements are displayed during operation of particular software can be varied

once those advertisements have been integrated into the software. In a system as in Claim 19, on the other hand, variation in the display of images generated from content data that has been acquired by the system is possible and is provided by the "means for selectively displaying" (see, e.g., the description in Applicants' specification at page 19, line 27 to page 22, line 27 of scheduling sets of content data for display by a content display system, and the particular discussions of content display system scheduling instructions in Applicants' specification at page 54, line 11 to page 55, line 9 and content data scheduling instructions in Applicants' specification at page 34, line 2 to page 35, line 1). Thus, a system as in Claim 19 can provide a more flexible and varied display than is possible with a system based upon the teaching of Pirani et al.

For the foregoing reasons, Pirani et al. neither teach nor suggest a system as recited in Claim 19, and, therefore, Claim 19 is allowable over the teaching of Pirani et al. Further, Claims 21 and 22, which each depend upon Claim 19, are allowable for at least the reasons given with respect to Claim 19.

Claim 46 recites:

A method for engaging the peripheral attention of a person in the vicinity of a display device of an apparatus, comprising:

acquiring a set of content data from a content providing system; and

selectively displaying on the display device, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from the set of content data.

Claim 46 recites a method having limitations similar to those of the system recited in Claim 19. Thus, for reasons similar to those given above with respect to Claim 19, Pirani et al. neither teach nor suggest a method as recited in Claim 46, and, therefore, Claim 46 is allowable over the teaching of Pirani et al. Further, Claim 48, which depends upon Claim 46, is allowable for at least the reasons given with respect to Claim 46.

As amended, Claim 66 recites:

A computer readable medium encoded with one or more computer programs for enabling a content display system to selectively display on a display device, in an unobtrusive manner that does not distract a user from a primary interaction with an apparatus associated with the display device, an image generated from a set of content data that is not integrated with the one or more computer programs, comprising:

- operating instructions for beginning, managing and terminating the selective display of the image on the display device;
- content display system scheduling instructions for scheduling the display of the image on the display device; and
- installation instructions for installing the operating instructions and content display system scheduling instructions on a content display system.

The computer program(s) stored on the computer readable medium of Claim 66 are not integrated with the set of content data. As discussed above with respect to Claim 19, this is not taught or suggested by Pirani et al. Consequently, unlike the software programs taught by Pirani et al., the computer program(s) of Claim 66 enable images to be generated from a wide variety of content data and content data can be used to selectively generate images for display.

For example, the computer program(s) of Claim 66 enable images to be generated from content data obtained from devices other than the apparatus associated with the display device on which the images are selectively displayed. (In particular, content data can be obtained from other devices via a computer network.) This is not contemplated by Pirani et al., as discussed in more detail above. Thus, the variety and number of images that can be displayed by the computer program(s) of Claim 66 is much more vast than that enabled by the "enhanced" software taught by Pirani et al.

Additionally, as also discussed above with respect to Claim 19, Pirani et al. do not teach or suggest that the manner in which advertisements are displayed during operation of particular software can be varied once those advertisements have been integrated into the software. With the computer program(s) of Claim 66, on the other hand, variation in the display of images generated from content data is possible and is enabled by the content display system scheduling instructions. Thus, the computer program(s) of Claim 66 can provide a more flexible and varied display than is possible with the "enhanced" software taught by Pirani et al.

For the foregoing reasons, Pirani et al. neither teach nor suggest a computer readable medium encoded with one or more computer programs as recited in Claim 66, and, therefore, Claim 66 is allowable over the teaching of Pirani et al. Further, Claim 67, which depends upon Claim 66, is allowable for at least the reasons given with respect to Claim 66.

The Examiner rejected Claims 1-19, 21-31, 33-46 and 48-67 under 35 U.S.C. § 102(e) as being anticipated by Judson.

As amended, Claim 1 recites:

A system for engaging the peripheral attention of a person in the vicinity of a display device of an apparatus, comprising:

- a content display system associated with the display device, the content display system including means for receiving a set of content data and a set of instructions for enabling a display device to selectively display, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from a set of content data, the content display system further including means for using the display device to selectively display the image or images using the set of instructions;

- a content providing system including means for providing a set of content data to the content display system;

- means for providing to the content display system a set of instructions for enabling a display device to selectively display an image or images generated from a set of content data;

- first communication means for enabling communication between the means for providing and the content display system; and

- second communication means for enabling communication between the content providing system and the content display system.

Judson teaches, at column 1, lines 59-63, that the invention "enhance[s] the operation of a web browser by causing the display of some useful information to [a] user during the period of user 'downtime' that otherwise occurs between linking and downloading of a hypertext document identified by [a] link." Though Judson is unclear on this point, it appears that the instructions for causing the display of the information are implemented as part of the browser, i.e., a browser is modified to perform the steps of the method described by Judson. Judson does not teach or suggest

that such instructions can be transferred from another device (e.g., from another computer via a computer network such as the Internet) to the computer used to display information to the user. Thus, Judson does not teach or suggest "a content display system ... including means for receiving ... a set of instructions for enabling a display device to selectively display ... an image or images generated from a set of content data," as recited in Claim 1.

Additionally, as indicated by the above-quoted section from the Judson patent, the method taught by Judson causes a computer to display information to the user during, and as part of, a primary interaction with the computer, i.e., during acquisition of information from other computers via a computer network (such as downloading web pages from other computers via the World Wide Web). In contrast, in the system recited in Claim 1, a content display system "selectively display[s], in an unobtrusive manner that does not distract a user of [an] apparatus from a primary interaction with the apparatus, an image or images generated from a set of content data" (emphasis added). This is neither taught nor suggested by Judson. The display of images in an unobtrusive manner in a system as recited in Claim 1 can be implemented by, for example, displaying images during an inactive period (e.g., when the user has not interacted with the apparatus for a predetermined period of time) of a primary interaction with the apparatus (the "screensaver embodiment"), as described, for example, at page 3, lines 16-20, page 5, lines 30-33, and page 12, lines 16-20 of Applicants' specification. The display of

images in an unobtrusive manner in a system as recited in Claim 1 can also be implemented by displaying images during an active period of a primary interaction with the apparatus, but in a manner that does not distract the user from the primary interaction (the "wallpaper embodiment"), as described, for example, at page 3, lines 20-27, page 6, lines 2-8, and page 12, lines 20-28 of Applicants' specification. This aspect of the invention makes use of "unused capacity" of a display device (see, e.g., page 12, lines 28-30 of Applicants' specification) and of the attention of a person in the vicinity of the display device (see, e.g., page 10, lines 11-14 of Applicants' specification). While a similar statement might be made of the method taught by Judson, it is important to note that the instant invention uses different unused capacity than that used by the method taught by Judson.

For the foregoing reasons, Judson neither teaches nor suggests a system as recited in Claim 1, and, therefore, Claim 1 is allowable over the teaching of Judson.

Claims 2-18 each depend either directly or indirectly on Claim 1, and are therefore allowable over the teaching of Judson for at least the reasons given above. Additionally, many of the limitations recited in Claims 2-18 are neither taught nor suggested by Judson. For example, Judson does not teach or suggest an application management system as recited in Claim 2 (see FIG. 2 of the instant application and accompanying description), or that such an application management system can provide the instructions for selectively displaying images

directly to a content display system (Claim 3) or indirectly via a content providing system (Claim 4). Judson also does not teach or suggest control instructions, including display instructions and content data scheduling instructions, as in Claim 5 (see, e.g., the description in Applicants' specification at page 31, line 8 to page 32, line 2 and page 34, line 2 to page 35, line 21). Further, Judson does not teach or suggest content data acquisition instructions as in Claim 6, or acquisition instructions and content data update instructions as in Claim 7 (see, e.g., the description in Applicants' specification at page 32, lines 3-11 and page 35, line 32 to page 36, line 28, and FIG. 4 and accompanying description). Additionally, Judson does not teach or suggest a plurality of sets of instructions for enabling a display device to selectively display an image or images generated from a set of content data, as in Claims 8, 10, 11 and 12, or that the sets of instructions can be tailored for use with particular content data (Claim 10) or display devices (Claim 12) and provided to a content display system as necessary to enable display of particular types of content data (Claim 11). Judson also does not teach or suggest auditing the display of content data, as recited in Claim 13 (see, e.g., the description in Applicants' specification at page 57, line 24 to page 59, line 26). The Examiner has not pointed out where Judson teaches any of these limitations.

Claim 19 recites "means for selectively displaying on [a] display device, in an unobtrusive manner that does not distract a user of [an] apparatus from a primary interaction with the apparatus, an image or images generated from [a] set of content data" (emphasis added). As discussed above with respect to Claim 1, Judson does not teach or suggest such means. Thus, Claim 19 is allowable over the teaching of Judson.

Claims 21-31 and 33-45 each depend either directly or indirectly on Claim 19, and are therefore allowable over the teaching of Judson for at least the reason given above. Additionally, many of the limitations recited in Claims 21-31 and 33-45 are neither taught nor suggested by Judson. For example, Judson does not teach or suggest displaying images in real time as the corresponding content data is acquired, as recited in Claim 23. Nor does Judson teach or suggest updating the content data, as recited in Claim 25, updating content data in the background while the user is engaged in other use of the apparatus (Claim 26), updating automatically (Claim 28) or specifying the location of updated content data and the time at which the updated content data is to be obtained (Claim 29). Judson also does not teach or suggest terminating the selective display of the images as a result of a predetermined user interaction, as recited in Claim 32. Judson does not teach or suggest providing control options during the selective display, as recited in Claim 33, and, more particularly, an "exit" option (Claim 34; see, also, the description in Applicants' specification at page 51, line 28 to page 52, line 2), a "next"

option (Claim 35; see, also, the description in Applicants' specification at page 52, lines 3-9), a "back" option (Claim 36; see, also, the description in Applicants' specification at page 52, lines 10-17), a "remove" option (Claim 37; see, also, the description in Applicants' specification at page 52, line 18 to page 53, line 2), a "no display until updated" option (Claim 38; see, also, the description in Applicants' specification at page 53, lines 3-32), a "satisfaction" option (Claim 39; see, also, the description in Applicants' specification at page 53, line 33 to page 55, line 9) and a link option (Claim 40; see, also, the description in Applicants' specification at page 55, line 10 to page 56, line 9). The Examiner has not pointed out where Judson teaches any of these limitations.

Claim 46 recites a method having limitations similar to those of the system recited in Claim 19; in particular, Claim 46 recites "selectively displaying on [a] display device, in an unobtrusive manner that does not distract a user of [an] apparatus from a primary interaction with the apparatus, an image or images generated from [a] set of content data" (emphasis added). As discussed above, this is not taught or suggested by Judson, and, therefore, Claim 46 is allowable over the teaching of Judson. Additionally, Claim 48, which depends on Claim 46, is allowable over the teaching of Judson for at least the reason given with respect to Claim 46.

Claim 49 recites:

A computer readable medium encoded with one or more computer programs for enabling acquisition of a set of content data and display of an image or images generated from the set of content data on a display device during operation of an attention manager, comprising:

- acquisition instructions for enabling acquisition of a set of content data from a specified information source;
- user interface installation instructions for enabling provision of a user interface that allows a person to request the set of content data from the specified information source;
- content data scheduling instructions for providing temporal constraints on the display of the image or images generated from the set of content data; and
- display instructions for enabling display of the image or images generated from the set of content data.

Judson does not appear to teach or suggest "user interface installation instructions for enabling provision of a user interface that allows a person to request [a] set of content data from [a] specified information source," as recited in Claim 49. Such user interface installation instructions are described in Applicants' specification at, for example, page 32, lines 11-19, and allow content providers to provide an interface that enables sets of content data (and, perhaps, instructions for displaying an image or images generated from the content data) to be requested from the content provider.

Judson also does not appear to teach or suggest "content data scheduling instructions for providing temporal constraints on the display of [an] image or images generated from [a] set of content data," as also recited in Claim 49. Such content data scheduling instructions are described in Applicants'

specification at, for example, page 19, line 27 to page 22, line 27 and page 34, line 2 to page 35, line 1, and enable content providers to provide constraints on the manner in which the content data they provide is used for display. Such constraints may relate to, for example, the duration of the display of the image(s) generated from the content data, the sequence in which clips of a set of content data are displayed (as well as the duration of the display of each clip), times at which the content data can or cannot be used to generate image(s) for display, and limitations on the number of times that a set of content data can be used to generate image(s) for display.

For the foregoing reasons, Judson neither teaches nor suggests a computer readable medium encoded with one or more computer programs as recited in Claim 49, and, therefore, Claim 49 is allowable over the teaching of Judson.

Claims 50-65 each depend either directly or indirectly on Claim 49, and are therefore allowable over the teaching of Judson for at least the reasons given above. Additionally, many of the limitations recited in Claims 50-65 are neither taught nor suggested by Judson. For example, claims 50-58 recite particular types of content data scheduling instructions, as discussed briefly above, that are not taught or suggested by Judson. Claims 61-63 recite content data update instructions; Judson does not teach or suggest acquiring updates of the information that is to be displayed during linking and downloading of a hypertext document. Claims 64 and 65 recite "content display system scheduling instructions" and "audit instructions" that do not

appear to be taught or suggested by Judson.

Claim 66 recites "operating instructions for beginning, managing and terminating the selective display of [an] image on [a] display device," where the selective display is done "in an unobtrusive manner that does not distract a user from a primary interaction with an apparatus associated with the display device" (emphasis added). As discussed above, the method taught by Judson causes a computer to display information to the user during, and as part of, a primary interaction with the computer, e.g., during downloading of web pages from other computers via the World Wide Web. Thus, operating instructions as recited in Claim 66 are neither taught nor suggested by Judson.

Further, though Judson teaches some flexibility in the display of information (see, e.g., column 7, lines 6-17), Judson does not appear to teach or suggest "content display system scheduling instructions for scheduling the display of [an] image on [a] display device," as recited in Claim 66. (See, e.g., the description in Applicants' specification at page 19, line 27 to page 22, line 27 and page 54, line 11 to page 55, line 9.)

For the foregoing reasons, Judson neither teaches nor suggests a computer readable medium encoded with one or more computer programs as recited in Claim 66, and, therefore, Claim 66 is allowable over the teaching of Judson. Further, Claim 67, which depends on Claim 66, is allowable over the teaching of Judson for at least the reasons given with respect to Claim 66.

The application from which the Judson patent issued was filed on October 19, 1995. The instant application was filed on March 22, 1996. At least the subject matter recited in Claims 1, 6, 7, 9, 14, 15, 18-22, 24-29, 31, 32, 41, 42, 45-49, 53, 54 and 61-63 was conceived and reduced to practice prior to October 1995, thus making the Judson patent inapplicable as a reference that can be used to reject those claims, and obviating the rejection of Claims 1, 6, 7, 9, 14, 15, 18, 19, 21, 22, 24-29, 31, 41, 42, 45, 46, 48, 49, 53, 54 and 61-63 as being anticipated by Judson. Applicants can submit Declarations under 37 C.F.R. § 1.131 stating facts that show conception and reduction to practice of the instant invention as described above. For example, accompanying this Response is a copy of a Declaration of Paul A. Freiburger Under 37 C.F.R. § 1.131 stating such facts. However, some of the inventors of the subject matter of Claims 1, 6, 7, 9, 14, 15, 18-22, 24-29, 31, 32, 41, 42, 45-49, 53, 54 and 61-63 have been unavailable to execute such a Declaration prior to submitting this Response. As soon as those inventors have executed a Declaration under 37 C.F.R. § 1.131 as indicated above, Applicants will submit such executed Declaration(s) to the Patent Office. Applicants expect such submission to occur no later than about two weeks from the date of this Response.

The Examiner rejected Claims 19, 20, 25-28, 32 and 41-47 under 35 U.S.C. § 102(a) as being anticipated by PointCast as described in the 2-13-96 Wall Street Journal article by Joan E. Rigdon.

The Wall Street Journal article describing the PointCast software was published on February 13, 1996. As discussed above with respect to the rejection of claims as anticipated by Judson, at least the subject matter recited in Claims 1, 6, 7, 9, 14, 15, 18-22, 24-29, 31, 32, 41, 42, 45-49, 53, 54 and 61-63 was conceived and reduced to practice prior to October 1995, thus making the Wall Street Journal article inapplicable as a reference that can be used to reject those claims, and obviating the rejection of Claims 19, 20, 25-28, 32, 41, 42 and 45-47 as being anticipated by the description of the PointCast software in the Wall Street Journal article.

Additionally, the description of the PointCast software in the Wall Street Journal article does not teach or suggest the limitations recited in Claims 41-44 regarding the type of content data displayed. In particular, there is no teaching or suggestion that the content data can be data representing a moving visual image (Claim 43) or audio data (Claim 44).

The Examiner rejected Claims 1-20, 22-47 and 49-67 under 35 U.S.C. § 102(a) as being anticipated by PCT publication number WO 96/30864 to Schena et al.

The Schena et al. PCT publication was published on October 3, 1996. The instant application was filed on March 22, 1996. Thus, the rejection of Claims 1-20, 22-47

and 49-67 under 35 U.S.C. § 102(a) appears to be improper, since the Schena et al. PCT publication does not show that the instant invention was "known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent" (Applicants' invention necessarily being conceived and reduced to practice no later than March 22, 1996).

In view of the foregoing, it is requested that the rejection of Claims 1-67 under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Claims 1-67 were pending and were rejected. Claims 1 and 66 have been amended. In view of the foregoing, it is requested that Claims 1-67 be allowed. If the Examiner wishes to discuss any aspect of this application, the Examiner is invited to telephone Applicants' undersigned attorney at (408) 945-9912.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on July 3, 1998.

7-3-98 David R. Graham
Date Signature

Respectfully submitted,

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